

REMARKS

Claims 13-20 are pending and presently under examination in the subject application.

Rejection under 35 U.S.C. § 102

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 13-15, 17, 19, and 20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Blissett et al. (U.S. Patent No. 4,866,860). The examiner contends that Blissett discloses a sole element comprising a first layer with a recess and an insert located in the recess and the periphery of the insert being unsecured to the first layer and the insert being made from a different material than the first layer. The examiner asserted that inserting a shoe having the Blissett sole in an "overshoe" that it would anticipate the claimed insert of the subject application.

In response, applicants respectfully dispute the characterization of Blissett as describing an insole and maintain that the concocting of a scenario whereby the shoe of Blissett is inserted in an "overshoe" to transform an outer sole of a shoe into an "insole" can only be based on impermissible hindsight gleaned from the teaching of the present application. In contrast, the entirety of the teaching of Blissett is directed to an integrated shoe with an outsole that makes contact with the ground. Nothing in Blissett discloses the production of an insole for use in a shoe, thus Blissett cannot anticipate the claimed insole.

More importantly, the sole construction and method of manufacturing disclosed in Blissett further distinguish the claimed invention from the shoe described in Blissett. Applicants maintain that the process steps recited in the claims cannot be disregarded merely because the claim is directed to a product produced by the

product. In fact, certain claim elements in the methods result in a product that is distinguishable from that disclosed in the cited art. In particular, in claim 13, the process steps require use of lifter in the molding apparatus that secures the insert "such that a peripheral edge of the insert supported of the insert supported on said lifter is clamped between said lifter and said lip..." The molding material is then supplied to the cavity with the insert thus secured. Applicants note that the pad 18 in Blissett is held in place in the molding apparatus merely by ridges or walls (Col. 6, lines 23-32) that do not duplicate the method of securing the insert disclosed in the subject application, thus not anticipating the resulting product from the method in the subject application. Further, in claim 14, the insert is said to comprise a material "having a second said property (cushioning, hardness, density, resilience or color) which is different from" the property from the first layer. In contrast, Blissett states that the "remainder of the outsole 14 is injection molded from the same thermoplastic rubber material as pads 18, 20." (Col. 6, lines 23-24).

Accordingly, applicants maintain that the shoe design described in Blissett does not anticipate the insole claimed in the subject application and respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 13-20 under 35 U.S.C. § 103 as allegedly being obvious in view of Hiles (U.S. Patent No. 4,808,469) and Crow (U.S. Patent No. 6,120,880) in view of Blissett. The Examiner contends that Hiles and Crow each show an insole comprising a first layer with an insert located in a recess in the first layer substantially as claimed

except for providing a space around the periphery of the insert. The Examiner asserts that Blissett teaches providing a space around the periphery of an insert and integrally molding the insert with the layer providing the recess. The Examiner concluded that it would have been obvious to provide a peripheral space and to integrally mold the elements as taught by Blissett in the insole of either Hiles or Crow to keep the pads in position during flexion and to make the insole more durable. With regard to claims 16 and 18, the Examiner contends that it is well known and conventional in the art of molding to provide a barrier layer between elements being comolded so that there is controlled mixing of the two materials and thus it would have been obvious to use a barrier in the processes of Hiles or Crow as modified by Blissett.

In response, applicants maintain that the arguments recited above with respect to the deficiencies of Blissett are applicable to this rejection as well and incorporate by reference those comments here. Because Blissett does not anticipate or render obvious the claimed invention for the reasons discussed above it cannot be used to cure the deficiencies the Examiner acknowledges exist in the Hiles and Crow patents. Applicants maintain that one of ordinary skill in the art would not have combined the teaching of Blissett with either of Hiles or Crow to arrive at the claimed insoles. Further, in particular with respect to claims 16 and 18, Blissett teaches only the use of the same thermoplastic rubber material for the pad 18 as for the remainder of the outsole 14. Thus, there is no motivation to alter the teaching of Blissett to address the problems solved by the claimed invention. Accordingly, applicants respectfully request the reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Applicants also request the reconsideration and withdrawal of the rejection of claims 16 and 18 under 35 U.S.C. § 103 as obvious over Blissett. The Examiner contends that Blissett shows an "insole" substantially as claimed but for a barrier

layer between the insert and the first layer. The Examiner contends that it is well known and conventional in the art of molding to provide a barrier layer between elements being comolded so that there is controlled mixing of the two materials and thus it would have been obvious to use a barrier in the processes of Blissett.

In response, applicants maintain the arguments above with respect to the deficiencies of Blissett are applicable to this rejection as well and incorporate by reference those comments here. Because Blissett does not anticipate or render obvious the claimed invention for the reasons discussed above, applicants need not make a further showing of patentability of the unobviousness of using a barrier layer in the claimed insole. Because Blissett teaches only the use of the same thermoplastic rubber material for the pad 18 as for the remainder of the outsole 14, there is no motivation to alter the teaching of Blissett to address the problems solved by the claimed invention. Accordingly, applicants respectfully request the reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

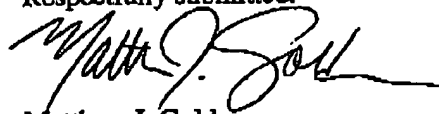
CONCLUSION

Applicants submit that the pending claims are in condition for allowance.

Accordingly, reconsideration of the rejections and allowance of the claims at an early date are respectfully requested.

If the undersigned can be of assistance in advancing the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted.



Matthew J. Golden
Reg. No. 35,161

Schering-Plough Corporation
Patent Department
Mail Stop K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, NJ 07033-0530

Phone: (908) 298-4741
Fax: (908) 298-5388